



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,853	01/26/2006	Yukitaka Shimizu	19070230PUS1	8106
2292	7590	09/09/2010	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				MUHAMMAD, KHALIF R
ART UNIT		PAPER NUMBER		
3685				
NOTIFICATION DATE		DELIVERY MODE		
09/09/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SEP - 8 2010

Michael R. Cammarata
Birch, Stewart, Kolasch & Birch, LLP
810 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of: Yukitaka Shimizu et al. : DECISION ON PETITION
Application No. 10/565,853 : TO WITHDRAW FINALITY
Filed: January 26, 2006 : OF OFFICE ACTION
For: ACCOUNTING SYSTEM CONTENT : UNDER 37 C.F.R. 1.181
REPRODUCTION DEVICE, LICENSE :
SALES DEVICE, PROGRAM AND :
RECORDING MEDIUM :
:

This is in response to applicants' petition under 37 CFR 1.181 filed on September 30, 2009 to have the restriction requirement dated July 28, 2008 withdrawn, and the finality of the August 6, 2009 Office action withdrawn.

This communication is also in response to applicants' petition filed on June 3, 2010 to i) have the finality of the March 04, 2010 Office Action withdrawn ii) transfer the Application to another Examiner and iii) ensure that Office Actions comply with 37 C.F.R. 1.104(c)(2), MPEP 707.07(f) and MPEP 707.07(d)

The petitions are **GRANTED-IN-PART**.

Applicants allege that the July 28, 2008 restriction requirement was improper in that the application was a national stage entry of an international application and therefore should be treated according to MPEP 1850 ("Unity of Invention").

37 CFR 1.499. Unity of invention during the national stage

If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

The record shows that on July 28, 2008, a restriction requirement was issued on new claims 14-32. In a response filed on August 28, 2008, petitioner elected Group I for examination. As part

of the remarks, however, petitioner also pointed out that the application was a national stage entry of an international application and therefore should be treated according to MPEP 1850 (“Unity of Invention”). As the instant application is a national stage entry of the international application PCT/JP04/09913, the claims should be restricted in accordance to rule 37 CFR 1.475. Therefore, the restriction requirement dated July 28, 2008 is improper.

Subsequently, several Office actions (a non-final action dated December 24, 2008 and final actions dated August 6, 2009 and February 3, 2010) which either did not address applicants' arguments with respect to the appropriateness of the original restriction or contained typographical errors (e.g. the examiner mistakenly cut-and-paste the wrong Office action into the February 3, 2010 action) were issued. A supplemental office action was issued on March 4, 2010 that included a proper restriction requirement per applicants' request and in line with MPEP 1850. The supplemental action was made final. The March 4, 2010 supplemental final was the examiner's good faith effort to resolve all outstanding matters and provide a complete Office action.

Nonetheless, as the July 28, 2008 restriction requirement was improper, the finality of the initial and each subsequent final Office action, including the March 4, 2010 Supplemental, is withdrawn. Applicants' request to have the finality of the March 4, 2010 Office action withdrawn is GRANTED.

In regard to applicants' request to have the application transferred to a new examiner, while petitioner's frustration is understandable, a review of the file history does not display any issues that would prevent the petitioner from receiving a fair examination of the invention. Nor is there any evidence of any arbitrary or capricious actions on the part of the examiner assigned to examine the application. Therefore, applicants' request to transfer the application new examiner is DENIED.

A third and final request by the applicants is for the application to be examined in accordance with MPEP 707.02, 37 CFR 1.104(c)(2) and MPEP 707.07(d) and (f).

In the March 4, 2010 Office action, the examiner applied a Unity of Invention restriction requirement (page 2, section 2), withdrew the finality of previous actions (page 3, section 8), identified what the examiner considered indefinite (pages 4-7, sections 10-19) and articulated why the claims are obvious in view of the prior art to one of ordinary skill in the art (pages 7-13, sections 20-30) including responding to applicants' arguments and articulating what the examiner considers as intended uses (page 3, section 9; pages 8-9, page 12, lines 3-9). Therefore, applicants have received an Office action in accordance with MPEP 707.02, 37 CFR 1.104(c)(2) and MPEP 707.07(d) and (f).

MPEP 1201 states that:

Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134). "

With respect to the 112 second paragraph rejection and what the examiner considers as "intended use", these and other matters related to the merits are not-petitionable subject matter. The issues raised by applicant are questions relate to the merits which go to the patentability of the claims. As such, these questions are matters appealable to the Board of Patent Appeals and Inferences, and not petitionable matters.

Accordingly the request for examination in accordance with MPEP 707.02, 37 CFR 1.104(c)(2) and MPEP 707.07(d) and (f) is dismissed.

As a matter of rights, applicants' response filed on June 3, 2010 will be entered and forwarded to the examiner for consideration.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Calvin L. Hewitt II at (571) 272-6709.



Wynn W. Coggins, Director
Technology Center 3600
(571) 272-5150

clh/lm: 9/2/10

LM